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| PRE-APPEAL BRIEF REQUEST FOR REVIEW  |  | Docket Number (Optional) |  |
|--|--|--------------------------|--|
|  |  | 0112634.00120US1         |  |
|  | Application Number                           | Filed                    |  |
|  | 09/923704                                    | August 7, 2001           |  |
|  | First Named Inventor<br>Peter MALCOLM et al. |                          |  |
|  | Art Unit                                     | Examiner                 |  |
|  | 3621   | P. E. Elisca             |  |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s).<br/>Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div><input type="checkbox"/> applicant /inventor.</div> <div><input type="checkbox"/> assignee of record of the entire interest.<br/>See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</div> <div><input type="checkbox"/> attorney or agent of record.<br/>Registration number _____</div> <div><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34.<br/>Registration number if acting under 37 CFR 1.34. <u>35,761</u></div> <div><br/>_____<br/>Signature<br/><br/>Rajesh Vallabh<br/>_____<br/>Typed or printed name<br/><br/>(617) 526-6000<br/>_____<br/>Telephone number<br/><br/>November 23, 2005<br/>_____<br/>Date</div> |  |                          |  |
| <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>  |  |                          |  |
| <input type="checkbox"/> *Total of <u>1</u> forms are submitted.   |  |                          |  |

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Dated: November 23, 2005

Signature:  (Jody Begley)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
(Attorney Docket Number 112634.120US1)

Applicant: Malcolm Examiner: Elisca, Pierre E.  
Serial No.: 09/923,704 Group Art Unit: 3621  
Filing Date: August 7, 2001  
For: INFORMATION MANAGEMENT SYSTEM

CERTIFICATE UNDER 37 C.F.R. § 1.8(a)

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

In the Final Office Action dated June 23, 2005 and the Advisory Action dated October 5, 2005, the Examiner continued to reject each of pending claims 1-46, 114-157, 178-261, 304-353, 377-418, 438-460, and 476-585 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,835,726 issued to Shwed et al. ("Shwed"). As discussed in Applicant's Response to Final Office Action dated August 5, 2005 ("Applicant's Response"), the office action however does not even address most of the claims in the application, much less present a prima facie case for the rejections. As to the claims that are addressed, there is clear error in the rejections.

**I. Independent claims 1, 24 and 438 and their respective dependent claims**

Claim 1 is directed to an information management system that includes a plurality of workstations adapted for connection to a computer network, and a data repository arranged to receive data from each of said workstations. The system includes policy data containing rules defining relevant commercial data which is to be stored in said data repository. The system also

includes an analyser for monitoring at least one of said outbound data and said inbound data, to identify in at least one of said outbound data and said inbound data, relevant commercial data that is to be stored in said data repository in accordance with said rules in said policy data, and to cause said relevant commercial data to be stored in said data repository. The system thereby identifies and stores relevant commercial data from inbound and/or outbound data transmitted or received by said workstations. (Non-limiting examples of such commercial data can include passwords/usernames, digital certificates, URLs, web pages, transaction amounts, goods and services, and transaction dates).

Shwed, on the other hand, discloses a packet filter for controlling information flow on a network to improve security. As explained, e.g., in the abstract of the reference, an incoming packet is judged against a filter language instruction and actions are taken accordingly. A packet may be rejected or accepted, or logged. If a packet is accepted, it may be modified by encryption, decryption, signature generation, signature verification or address translation. Shwed is thereby only concerned with security; Shwed does not analyze inbound or outbound data from or to a workstation to identify any relevant commercial data or store identified relevant commercial data in a data repository.

The incoming packets of Shwed that are trapped and processed are not themselves relevant commercial data. Even if, for the sake of argument, one were to consider Shwed's packets to be relevant commercial data, the elements of claim 1 would still not be met by the reference. Shwed would still not disclose "policy data containing rules defining relevant commercial data" as specified in claim 1. The rules in Shwed define the packets themselves only in terms of destination, sender addresses and service type, and not in terms of any relevant commercial data.

Additionally, an interpretation of the packets as relevant commercial data would mean that the modifying or logging of the packets be relevant commercially, and yet the only need to stop packets disclosed in Shwed is security. There is therefore no storage of relevant commercial data. Furthermore, no description is given in Shwed of what logging a packet on the system entails. It could just be an entry that a packet was detected and modified, rather than the packet itself. Claim 1 and its dependent claims 2-23 are therefore patentable over Shwed.

Moreover, as discussed in further detail in Applicant's Response (pages 3-4), with respect to dependent claim 9, Shwed further does not disclose or suggest identification or storage of digital certificates.

As discussed in Applicant's Response (page 4), independent claims 24 and 438 also generally relate to identifying and storing relevant commercial data. These claims and their respective dependent claims are similarly patentable over Shwed.

## **II. Independent claims 114, 136 and 476 and their respective dependent claims**

*None of these claims were addressed in the office action.* Claim 114 is directed to an information management system that includes an analyser operable in conjunction with policy data to monitor outbound data from a workstation and to determine, in accordance with said rules in said policy data, an appropriate encryption strength for the outbound data; wherein said analyser controls transmission of said outbound data from said application in dependence upon said determination of an appropriate encryption strength. As explained in further detail in Applicant's Response (pages 4-5), these elements are neither disclosed, nor suggested by Shwed. Claim 114 and its dependent claims 115-135 are thus patentable over Shwed.

As discussed in Applicant's Response (page 5), independent claims 136 and 476 also generally relate to determining an appropriate encryption strength for outbound data and controlling transmission accordingly. These claims and their respective dependent claims are similarly patentable over Shwed.

## **III. Independent claims 178, 220 and 498 and their respective dependent claims**

*None of these claims were addressed in the office action.* Independent claim 178 is directed to an information management system that includes an analyser operable in conjunction with said policy data to analyse at least one of said outbound data and said inbound data, to identify the existence of a commercial transaction occurring between a client workstation and a third party by analysing said outbound or said inbound data, and to cause transaction data that is all or part of said outbound data or said inbound data related to an identified commercial

transaction to be stored in said data repository. The system can thereby, e.g., identify and store online transactions as they occur, providing a valuable record of data, e.g., for accounting and audit purposes. As explained in detail in Applicant's Response (page 6), such a system is not disclosed or suggested by Shwed. Claim 178 and dependent claims 179-219 are thus patentable.

As discussed in Applicant's Response (pages 6-7), independent claims 220 and 498 also generally relate to identifying the existence of a commercial transaction and storing transaction data. These claims and their respective dependent claims are similarly patentable over Shwed.

#### **IV. Independent claims 304, 329 and 540 and their respective dependent claims**

*None of these claims were addressed in the office action.* Independent claim 304 is directed to an information management system that includes an analyser operable in conjunction with said policy data to identify in at least said outbound data, transaction data that may be part of a transaction, and to make a determination in accordance with said rules of said policy data as to whether the transmission of said transaction data would satisfy said rules; and wherein the transmission of said transaction data by said application is dependent on said determination made by said analyser. As a non-limiting example, the system is able to allow the commercial transactions of a plurality of users to be managed centrally, allowing a financial director, say, to review transactions before they occur, or even possibly to prevent them.

Shwed in no way discloses or suggests a system in which commercial transactions are identified. It therefore has no rule for identifying transaction data, and as mentioned above is only concerned with the security of a messaging system.

As discussed in Applicant's Response (pages 7-8), independent claims 329 and 540 also generally relate to identifying transaction data that may be part of a transaction and transmitting the transaction data. These claims and their respective dependent claims are similarly patentable over Shwed.

#### **V. Independent claims 377, 398 and 565 and their respective dependent claims**

*None of these claims were addressed in the office action.* Independent claim 377 is directed to an information management system that includes an analyser operable in conjunction with said application to monitor said inbound data and to identify in at least said inbound data, signed data that has been digitally signed with a digital certificate, to extract one or more details of said signed data and to determine whether or not verification is required for said digital certificate. The system also includes policy data, accessible by said analyser, containing rules which define whether or not verification is required for said digital certificate. The analyser determines whether or not verification is required for said digital certificate in dependence on said rules of said policy data and in dependence on said one or more details of said signed data extracted by said analyser.

Shwed is only concerned with the security of a network. The reference does not mention digital certificates, much less any functionality to manage how and when their authenticity is to be verified. Claim 377 and dependent claims 378-397 are patentable over Shwed.

As discussed in Applicant's Response (pages 8-9), independent claims 398 and 565 also generally relate to identifying signed data that has been digitally signed with a digital certificate and determining whether or not verification is required. These claims and their respective dependent claims are similarly patentable over Shwed.

For the reasons set forth above, the claim rejections should be withdrawn.

Respectfully submitted,



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Rajesh Vallabh (Reg. No. 35,761)  
Attorney for Applicants

Date: November 23, 2005  
Wilmer Cutler Pickering Hale and Dorr LLP  
60 State Street  
Boston, MA 02109  
(617) 526-6505  
(617) 526-5000 (Facsimile)